

DETAILED ACTION

Election/Restrictions

1. Newly submitted claim 9 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: It is a method of use claim, and the apparatus can be used with a different method

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 9 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 2 sets forth method steps, however, depends from an apparatus claim. It is unclear which statutory class of invention the applicant is intending to claim. As claim 2 depends from claim 1, for an apparatus, the examiner will, for the sake of examination, assume this to be a structural limitation limited to the pulling control means, and the additional limitations to be functional.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap, JR (U.S. Patent Application No. 2005/0043854) in view of Nedblake (U.S. Patent Application No. 2005/0237201).

Dunlap, JR (Dunlap) discloses an automated warehouse system operated by moving a transfer apparatus along a first rack in a warehouse and storing or retrieving containers, the containers having RFID tags; a first reading means for reading the container ID without pulling the container out of the first rack, and second reading means for reading ID tag while pulling containers out of the first rack, 16 provided in the transfer apparatus (para. [0014], ln 8-9), the examiner notes that Dunlap discloses one or more readers, which would encompass two readers; a control means for setting a speed of pulling the container [0018]; the first and second reading means are provided in the transfer apparatus on a side facing the first rack, the transfer apparatus includes a stacker crane 140 with a truck movable in a direction parallel with the rack, figure 5, a mast 142, a hoisting frame 144, and a transfer means 144, a first reading means 18 positioned on the left and right ends of the hoisting frame and the second reading means on one upper positions near

the left and right ends of the hoisting frame, see figure 3; a second rack is provided on the right side.

Dunlap fails to disclose the pulling control means sets a low speed for reading the ID tag, and a high speed when not reading the speed. However, it is within the skill of an ordinary mechanic to reprogram an existing controller.

Dunlap fails to disclose ID tags attached to individual articles in the container.

Nedblake discloses ID tags on both the container and individual articles, figure 2, in order to keep track of inventory (see abstract). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention to include Nedblake's ID tags on both the container and articles in Dunlap's warehouse system in order to keep track of inventory.

The Dunlap in view of Nedblake combination fail to disclose ID tags on both sides of the container. It would have been obvious to a person having ordinary skill in the art at the time of invention to include the additional ID tag on the container, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis.*, 193 USPQ 8.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap, JR (U.S. Patent Application No. 2005/0043854) in view of Nedblake (U.S. Patent Application No. 2005/0237201) in view of Bonneton et al (U.S. Patent No. 4,678,390).

The Dunlap in view of Nedblake combination discloses space for arranging two containers on the hoisting frame and can be transferred from the hoisting from to the rack, see figure 5.

The Dunlap in view of Nedblake combination fails to disclose internal transfer means.

Bonneton et al. (Bonneton) discloses an internal transfer means, see figure 4, on a stacker crane in order to better distribute weight for transport. Therefore it would have been obvious to a person having ordinary skill in the art at the time of invention to include Bonneton's internal transfer means in the Dunlap in view of Nedblake combination in order to better distribute weight for transport.

Response to Arguments

8. Applicant's arguments filed 08/18/2008 have been fully considered but they are not persuasive.

9. In response to applicant's argument that none of the cited references "teach or even suggest a system wherein IDs of individual articles in a container are read by scanning the articles *while pulling the container onto the transfer apparatus*."

(Applicant's remarks, page 6), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

10. In regards to the applicant's arguments concerning the pulling control means, please see the rejection above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA I. RUDAWITZ whose telephone number is (571)272-7856. The examiner can normally be reached on Monday - Friday, 7:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saul Rodríguez can be reached on 571-272-7097. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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